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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,211	01/28/2004	Frederick J. Dojan	005127.00275	2584
22909	7590	09/23/2005	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			KAVANAUGH, JOHN T	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,211

Applicant(s)

DOJAN ET AL.

Examiner

Ted Kavanaugh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-109 is/are pending in the application.
- 4a) Of the above claim(s) 10, 16, 17, 21-23, 32, 33, 43-45, 77-79, 89 and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15, 18-20, 24-31, 34-42, 46-76, 80-88 and 91-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-13-04&4-29-05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 10,16-17,21-23,32-33,43-45,77-79 and 89-90 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election of species I (figures 1-11) was made **without** traverse in the reply filed on September 14, 2005.

Claim Rejections - 35 USC § 112

2. Claims 15,24,38,60 and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 15,38,60,82, the foam (18) of the elected embodiment (figures 1-11) does not extend between the upper and both the bladder and the reinforcing structure.

Claim 24 is unclear and indefinite. The reinforcing structure of the embodiment as claimed is of one material and the claims call for a first and second material and therefore it would appear these claims don't read on the elected embodiment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

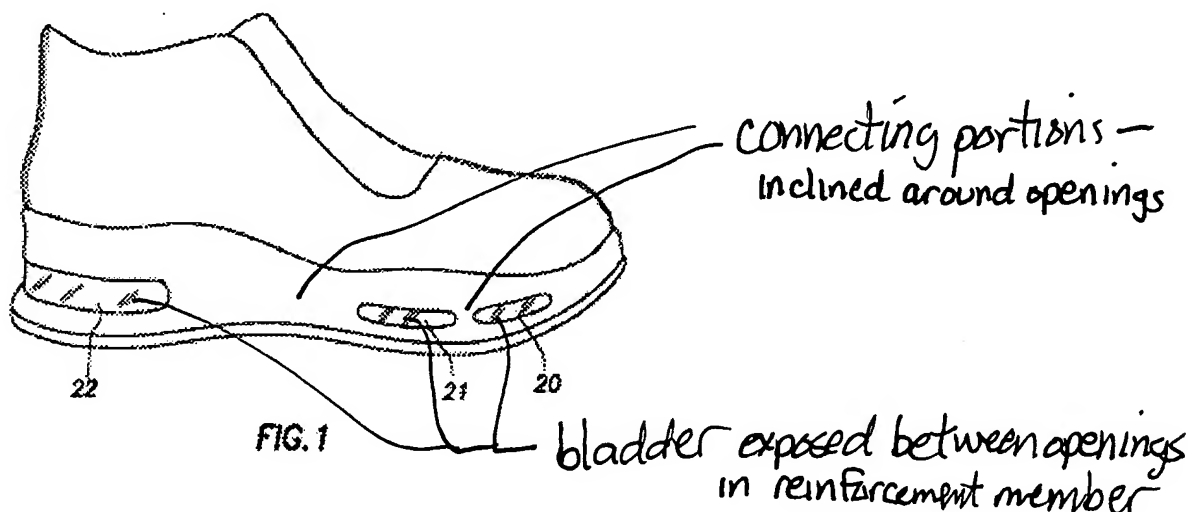
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

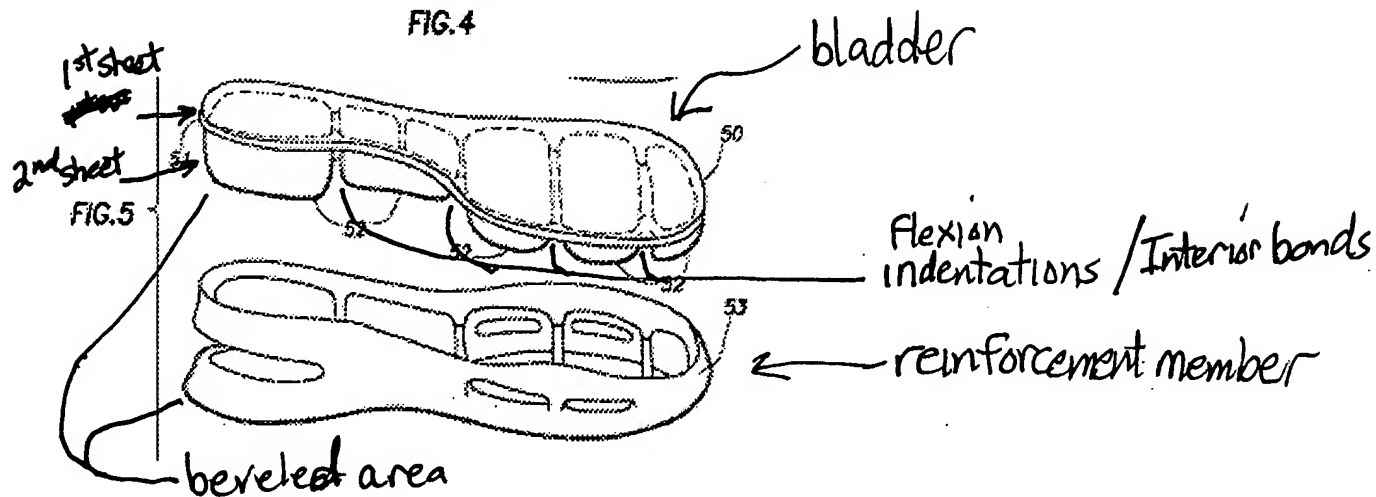
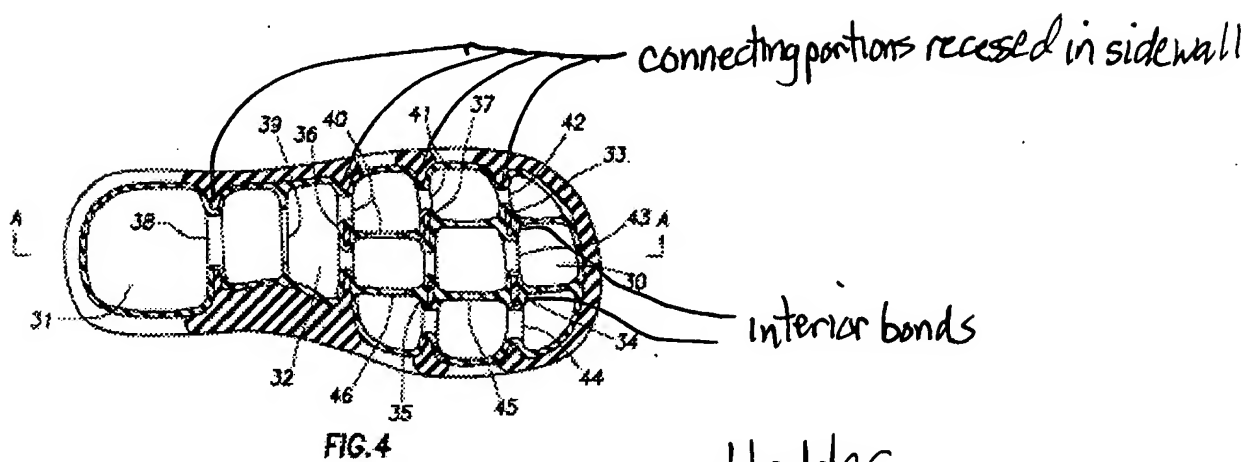
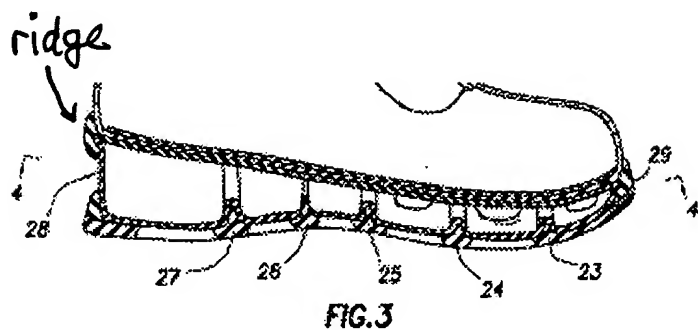
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,2,4-9,11,12,14,15,18-20,24,25,26,28-31,35,37-42,46-56,59,60-70,73-76,96-99 and 101-109 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6009637 (Pavone). Pavone teaches an article of footwear comprising an upper and a sole structure as claimed; see the marked-up figures below. a sole component as claimed including a bladder and a reinforcing structure at least partially recessed into the barrier material as claimed. See the marked-up figures below. When the bladder is inflated to a certain point and/or there is a great enough force applied (i.e. the force created upon impact upon the wearer's foot) to the bladder, it will inherently place the connecting portions of the reinforcing structure in tension. When such a force is applied the sidewalls of the bladder will create an outward force and hence place the connecting portions in tension. Also, the reinforcing structure will inherently restrain distension of the surfaces of the bladder. Regarding claims 24 and 46, as understood, the outsole (54) of Pavone represent a second different material of the reinforcing structure.





Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13,27,28,58,80-88,92-94 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone '637.

Pavone teaches a sole component as claimed (as noted above) except the modulus of elasticity of the materials as claimed. Pavone are silent with regard to the modulus of elasticity. However, it is conventional and well known in the art for bladder to have a lower modulus of elasticity than the structure enclosing the bladders. Bladders have a lower module of elasticity inasmuch as bladders in the footwear art provide a cushioning effect for the wearer. Therefore, it would have been obvious to provide the reinforcing structure of Pavone with greater modulus elasticity than barrier material of the bladder.

Regarding claim 100, it is old and conventional in the art to join footwear elements together by adhesive. Therefore, it would have been obvious to directly bond the bladder and reinforcing structure to the upper by adhesive to provide a secure bond.

7. Claims 3,34,35,36,57,71,72,91,93,95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone '637 in view of US 4817304 (Parker et al.).

Pavone teaches an article of footwear as claimed (see the rejection above) except for interior bonds formed by joining the first and second surface of the bladder together. Parker teaches footwear bladder (insert 20) with interior bonds formed by joining the first and second surface of the bladder together; see col. 4, lines 29-41. It would have been obvious to provide the bladder (module 31) of Pavone with interior

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bonds, as taught by Parker, to better conform the bladder to the individual wearer's foot.

Regarding claims 35 and the like, the interior bonds as taught above will naturally form indentations that inherently will be flexible.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-9,11-15,18-20,24-31,34-42,46-76,80-88,91-109 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/767212, 10/767465 and 10/767404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claim is merely broader than the patent claim and therefore it would be obvious to leave out the other elements.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

--"The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references."

--"A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

-Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.


11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
September 21, 2005